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#70/Petition
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PETITION TO THE COMMISSIONER

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PETITIONER: Ole K. Nilssen
Caesar Drive
Barrington, IL 60010

MAR 1 1990
GROUP 210

Re: Patent Application Serial No. 06/787,692
Filed: 10/15/85
Title: INVERTER WITH RESONANT L-C CIRCUIT
Art Unit: 212
Examiner: William H. Beha

I, OLE K. NILSSEN, HEREWITH
CERTIFY THAT THE DATE OF
DEPOSIT WITH THE U.S. POSTAL
SERVICE OF THIS PAPER OR FEE
IS: 2-23-90

Commissioner of Patents and Trademarks
Washington, D.C. 20231

In response to Examiner's Office Action dated 02/14/90,
the above-named Petitioner herewith requests of Commissioner
-- under 37 CFR 1.181 -- to:

- (1) reverse Examiner's holding of abandonment of subject application;
- (2) reverse Examiner's refusal to enter new claims 145 and 146; and
- (3) remove this particular Examiner from the prosecution of this and the several others of Petitioner's applications presently being handled by this Examiner.

In support of this Petition, Petitioner provides the following comments.

(a) On November 30, 1989, Petitioner received a Board action with respect to an Appeal related to subject application. In this action, the Board remanded the application to Examiner to reconsider the indicated allowability of certain claims that Examiner had previously allowed.

(b) In its action, the Board stated that any Board decision which includes a remand (as here) can not be considered a final one. Consequently, Petitioner interprets the Board's action as a non-final office action to his application; which, as far as Petitioner can understand, provides for Petitioner an unrestricted opportunity to amend his claims.

(c) So, in response to the Board's comments regarding the previously allowed claims and the non-finality of its office action, Petitioner -- in his Amendment E -- amended his previously allowed claims in such manner as to obviate the Board's concerns, and he also used the opportunity to substitute two new claims for the two confirmed-rejected claims.

(d) In his response to Petitioner's Amendment E, Examiner states that:

"Applicant's reply ... to the board's decision ... is deemed to be non-responsive for several reasons".

The first reason for non-responsiveness cited by Examiner is expressed thusly:

"the new grounds of rejection raised by the board does not reopen prosecution except as to the subject matter to which the new rejection was applied".

On that basis, Examiner refused entry of the new claims.

Petitioner believes Examiner's position to be incorrect in that he recites no procedural authority -- such as a paragraph from 37 CFR or from MPEP -- in support of his position.

In any case, even if Examiner's position were to be based on correct procedure, Petitioner's actions would not in any manner indicate non-responsiveness. Rather, they would indicate over-responsiveness.

The second reason for non-responsiveness cited by Examiner relates to Petitioner's amendments of the previously allowed claims and (with reference to 37 CFR 1.111b and 1.119) is expressed thusly:

"applicant's reply is non-responsive because it fails to point out how and why the recitations of the claims define novelty over, or are non-obvious over, Walker".

Examiner has no reasonable basis for this statement.

In commenting on the amended claims (claims 139-142), in the next-to-last paragraph on page 1 of his Amendment E, Applicant (Petitioner) refers to lines 3-17 on page 7 of the Board's opinion (which deals with anticipation by Walker), and states that the amendments have obviated what to Petitioner appeared to be the Board's concerns.

That is, in the next-to-last paragraph on page 1 of his Amendment E, Applicant does point out how and why the amended claims distinguish over Walker. To provide more detailed explanations than provided in that next-to-last paragraph would be unnecessary and probably offensive to a person having ordinary skill in the art pertinent hereto.

The third reason for non-responsiveness cited by Examiner also relates to Petitioner's amendments of the previously allowed claims and is expressed thusly:

"The reply is similarly non-responsive because it fails to point out how and why the claims are non-obvious over Franke considered with Bedford".

Examiner has no reasonable basis for this statement either.

In the last paragraph on page 1 of his Amendment E, Applicant does point out how and why the amended claims distinguish over Franke. To provide more detailed explanations than provided in that last paragraph would be unnecessary and probably offensive to a person having ordinary skill in the art pertinent hereto.

It is not clear to Applicant why Examiner introduced the Bedford reference in connection with the rejection over Franke. The Board proposed the possible rejection of claims 139-142 over Franke; but, as far as Applicant can see, did not add the Bedford reference to that proposed rejection.

(e) Contrary to what Examiner apparently believes, the Board did not formally reject claims 139-142. Rather, by remanding the application to Examiner for him to reconsider the indicated allowability of claims 139-142, the Board merely suggested to Examiner that claims 139-142 might not be allowable.

Thus, until Examiner does in fact disallow claims 139-142 (in their original form), they stand as being allowable.

Hence, absent an official Examiner's action to the effect of accepting, rejecting or modifying the Board's mere suggestion of non-allowability, claims 139-142 stand officially allowed; and it seems totally inappropriate for Examiner to hold the application abandoned when it contains claims that have been officially allowed by Examiner and not officially rejected by the Board.

Of course, with the original claims standing allowed, the amended claims would be allowable de facto.

On top of all that, the Board made a clear statement to the effect that its office action could not be considered as being a final one.

(f) On several previous occasions, relative to this and other applications pending before this Examiner, Petitioner expressed his concerns (as via various petitions) about his inability to deal productively with this particular Examiner.

The fact that this particular Petition constitutes Paper No. 71 in the course of this application's prosecution under subject Examiner is illustrative of the situation.

In Applicant's view, the reason for this extraordinary absence of productive results is related to a basic conflict between the modus operandi of this particular Examiner and that of this particular Petitioner.

From Petitioner's perspective, Examiner is: (i) overly zealous in the execution of his duties; (ii) frequently disregarding of proper procedure; and (iii) exceptionally lacking in skill pertinent to the particular arts associated with Petitioner's applications.

For the sake of improved productivity, both for the PTO and for the Petitioner, Petitioner herewith requests of the Commissioner to assign to another examiner this as well as all other of Petitioner's applications presently pending before this particular Examiner.

CONCLUDING REMARKS

In his latest office action, Examiner expresses his opinion to the effect that Petitioner's Amendment E was intentionally deficient. That is, Examiner believes that Petitioner submitted a response to the Board action that was intentionally deficient.

Petitioner -- who, of course, is the only person in the position to know the fact in this case -- herewith states and verifies that he did not in any way submit a response that was intentionally deficient.

Quite the contrary.

Even now, after having been expressly informed of Examiner's position, Petitioner still believes that his response to the Board's action was and is totally appropriate.

Moreover, on basis of very extensive dealings with other examiners at the PTO, Petitioner is totally convinced that most any other examiner at the PTO would have found Petitioner's response to be totally appropriate.

